<u>REMARKS</u>

Favorable reconsideration of this application is respectfully requested.

Claims 1-59 are pending in the application.

In the outstanding Office Action, claims 1, 5, 6, 17, 20, 24, 25, 36, 38, 39, 43, 44 and 55 were rejected under 35 U.S.C. § 102(e) as anticipated by <u>Yamada</u> (U.S. Patent No. 6,239,837 B1). Claims 19 and 57 were rejected under 35 U.S.C. § 103(a) as unpatentable over <u>Yamada</u> in view of <u>Nakatani</u> (U.S. Patent No. 5,063,459). Claims 2, 5, 6, 16, 21, 24, 25, 35, 40, 43, 44, and 54 were rejected under 35 U.S.C. § 103(a) as unpatentable over <u>Yamada</u> in view of <u>Wakui</u> (U.S. Patent No. 5,742,339). Claims 7-9, 11-15, 26-28, 30-34, 45-47 and 49-53 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of <u>Yamada</u> and <u>Wakui</u> applied to claims 2, 21 and 40 above and further in view of <u>Yoshiura et al.</u> (U.S. Patent No. 5,854,693, herein "<u>Yoshiura</u>"). Claims 3, 4, 22, 23, 41, and 42 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of <u>Yamada</u> and <u>Wakui</u> as applied to claims 2, 21, and 40 and further in view of well known prior art. Claims 18, 37, and 56 were rejected under 35 U.S.C. § 103(a) as unpatentable over <u>Yamada</u> in view of well known prior art. Claims 10, 29, and 48 were rejected under 35 U.S.C. § 103(a) as unpatentable over combination of <u>Yamada</u>, <u>Wakui</u> and <u>Yoshiura</u> as applied to claims 8, 27 and 46 above, and further in view of <u>Ikegaya</u>.

Addressing the above-noted rejections, those rejections are traversed by the present response.

The independent claims are amended by the present response to clarify features recited therein. Specifically, independent claim 1 recited an operator could select an "arbitrary selection of files" to be transferred. That language is now further clarified to recite the operator can select "an arbitrary selection of one or plural of any of files included in the image data". Independent claim 1 now also further recites "wherein when the flag is set

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transfer of the files selected by the user is interrupted before a first of the files is started to be transferred". The other independent claims are amended to recite similar features.

The claimed features are believed to be clear from the discussion in the original specification for example at page 27, line 10 et seq., and see also the discussion at page 30, line 5 et seq. The claims as written are directed to a situation in which an operator selects files to be transferred from, for example, an internal memory to an external memory. As a non-limiting example, if that external memory is a CD-R or a CD-RW, if the capacity of that external memory cannot store all of the files selected to be transferred, that results in not only a wasteful transfer operation, but also inefficiently use of the storing medium, particularly for example in the case of a CD-RW in which data can only be written a certain number of times.[1]

The claim amendments clarify operations in the claimed invention that an operator can select from image data any of one or plural files to be transferred. In the claimed invention, before any of the files selected by the operator are transferred to the external memory, it is determined whether the capacity of the external memory is large enough to record all of the files, and if the external memory does not have a great enough capacity to record all of the files then a flag is set. That setting of the flag interrupts the transfer of the files before even a first of the files is started to be transferred. That is, as clarified in the claims, when the flag is set none of the files selected by the operator are started to be transferred.

Such operations in the claimed invention are believed to clearly distinguish over Yamada, cited as a primary reference in each of the outstanding rejections.

First, Yamada is directed to a different type of device than as claimed. Yamada is directed to a digital camera that allows a copy mode in which data from an internal main

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[1] See for example the discussion in the present specification at page 27, lines 15-24.

memory MM is transferred to an external auxiliary memory card MC. Yamada also discloses

that when the external memory MC is attached to the camera data is automatically and

preemptively stored in that external auxiliary memory MC, and not in the main memory MM

in the camera.[2]

Yamada also appears to disclose an operation in a copy mode in which all of the files

in the main memory MM are transferred to the auxiliary memory MC.

That operation in Yamada differs from the claims as written as in Yamada the

operator does not select certain of files to be transferred. That is, in the copy mode in

Yamada it appears all of the files from the main memory MM are transferred to the auxiliary

memory card MC.

In maintaining the outstanding rejection, and with respect to the features as noted

above, the outstanding Office Action states:

> With regard to the arbitrary selection of files by the
> user, Yamada discloses allowing an operator to make a
> selection of files to be transferred (column 10, lines 1-46).
> Also note that any selection of files, such as all of the files
> available, still reads on an arbitrary selection. Furthermore
> Yamada also gives an indication as to how many files may be
> transferred before the auxiliary storage becomes full (column
> 10, lines 1-46).[3]

In reply to that grounds for rejection, applicants respectfully submit the outstanding

rejection is improperly dismissing claim features relative to the teachings in Yamada.

First, as noted above, the claims now clarify the selection by the operator can be "an

arbitrary selection of one or plural of any of files included in the image data". Yamada does

not disclose or suggest such features as in Yamada it appears all the files from the main

memory MM are designated to be transferred to the auxiliary memory card MC. Applicants

also note at column 10, lines 1-46 Yamada does not appear to disclose any indication that an

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[2] Yamada at col. 9, lines 37-40.
[3] Office Action of October 3, 2007, page 3, middle paragraph.

operator can arbitrarily select one or plural of files from the main memory MM for transfer, and the Office Action has not pointed to any actual disclosure in <u>Yamada</u> that teaches such a feature.

Moreover, applicants respectfully submit the interpretation that transferring all of the files available reads on an "arbitrary selection" is an unreasonable interpretation, and is further traversed in view of the above-noted clarifications in the claim language.

Also, <u>Yamada</u> providing an indication as to how many files may be transferred before an auxiliary storage becomes full does not correspond to the claimed features of allowing an operator to arbitrarily select one or plural files from image data to be transferred.

Thereby, applicants respectfully submit <u>Yamada</u> does not in fact disclose or suggest the above-noted claim features.

Moreover, as also noted above, the claims now further recite "wherein when the flag is set transfer of the files selected by the user is interrupted before a first of the files is started to be transferred". <u>Yamada</u> does not disclose or suggest such a feature.

<u>Yamada</u> merely discloses that when one auxiliary memory card MC is filled up, data from the memory MM is evacuated into a predetermined inner register until another auxiliary memory card is attached thereto, and then the remaining data is transferred into the another auxiliary memory card MC.[4]

In contrast to such operations in <u>Yamada</u>, in the claims a determination is made as to whether the external storage has a great enough capacity to store all of the designated files by the operator prior to the start of the transfer of any file in the image data, and when it is determined that such a capacity is not great enough, the file transfer is "interrupted before a first of the files is started to be transferred". <u>Yamada</u> does not operate in that way. In <u>Yamada</u> all files in the main memory are designated to be transferred, and if all of those files

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[4] <u>Yamada</u> at col. 12, lines 18-39.

cannot be transferred in one operation as many files as possible are transferred, and then the remaining files are transferred to a next memory card. The claims recite a contrary operation. In the claims, if all the files designated by an operator to be transferred cannot be transferred because of an insufficient capacity of the external memory, a flag is set, and then transfer of the files is interrupted before even a first of the files is started to be transferred. Yamada clearly does not operate in that manner.

In maintaining the outstanding rejections, and with respect to features as noted above, the outstanding Office Action states:

> With regard to the feature of setting a flag if the capacity is less than the total capacity needed to store the files, Yamada discloses an indication of the storage space available for files to be transferred and when the space is insufficient [for] file transfer it is indicated (column 10, lines 28-34). This indication that is specifically disclosed by Yamada is interpreted as a flag. Yamada provides a clear indicator or flag when the space [for] transferring files is insufficient.[5]

In reply to that grounds for rejection applicants note the claims as written recite a structure and operation that distinguish over Yamada. The claims now clarify the setting of the flag results in interrupting the file transfer before a first of the files is started to be transferred. Yamada does not operate in that manner. In Yamada if a storage capacity of the external memory card MC is not large enough to store all the files, still as many files as possible are transferred until another memory card MC is provided. Yamada does not stop a transfer before even a first of the files designated to be transferred is started to be transferred.

In view of the foregoing comments, applicants respectfully submit the claims as currently written clearly distinguish over Yamada.

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[5] Office Action of October 3, 2007, page 8, last full paragraph.

Moreover, no teachings in any of the further cited references to <u>Nakatani</u>, <u>Wakui</u>, <u>Yoshiura</u>, newly cited U.S. patent 6,678,801 to <u>Greim et al</u>, or well known art are believed to cure the above-noted deficiencies of <u>Yamada</u>.

In view of the foregoing comments, applicants respectfully submit the claims as currently written distinguish over the applied art.

As no other issues are pending in this application, it is respectfully submitted that the present application is now in condition for allowance, and it is hereby respectfully requested that this case be passed to issue.

Respectfully submitted,

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